Appl. No.: 10/715,790
Amendment dated May 3, 2006
Reply to Office Action of February 3, 2006

REMARKS/ARGUMENTS

In view of the following remarks, reexamination and reconsideration of this application, withdrawal of the rejections, and formal notification of the allowability of all claims as presented are earnestly solicited. Claims 1, 3, 5-12, 17-21, 23, 25-32, 37-41, 43 and 45-52 are pending. In response to the Office Action, Applicants respectfully traverse the pending rejections as indicated herein. Accordingly, it is believed that the pending claims define patentable subject matter over the references cited by the Examiner and notice to such effect is requested at the Examiner's earliest convenience.

Claim Rejections – 35 U.S.C. §103

Claims 1, 6-9, 21, 26-29, 41 and 46-49

The Office Action indicates that Claims 1, 6-9, 21, 26-29, 41, and 46-49 are rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent Application No. 2003/0169460 to Liao *et. al.* ("Liao"). Claims 1, 21, and 41 (and Claims 6-9, 26-29, and 46-49 depending respectively therefrom) recite a system, method, and computer program product, respectively, capable of **visually representing the required bandwidth for transmitting and receiving** signals on the current communications system **in addition to the available bandwidth** of the current communications system. Therefore, Claims 1, 21, and 41 recite that embodiments of the present invention are capable of determining **and displaying** a **bandwidth that is required** to transmit signals via the current communications system **relative to the bandwidth that is currently available** via the current communications system.

The Office Action includes an admission that "Liao **does not specifically disclose** wherein the display is further capable of **visually representing the required bandwidth for transmitting and receiving** signals on the current communications system." However, the Office Action further states that: "it would have been obvious to a person skilled in the art at the time the invention was made to modify Liao to **display the bandwidth determined necessary to transmit and receive signals**, as Liao teaches calculating the bandwidth needed to transmit and receive to and from a communication system."

However, Liao teaches away from the **display** of the **required** bandwidth for transmitting and receiving signals on the current communications system **prior to modifying communications therewith.** Specifically, there is **no reason** for the system disclosed in Liao to **display the required bandwidth** for transmitting and receiving signals on the current communications system **prior to modifying communications therewith**, because Liao discloses that the system performs an algorithm to allocate bandwidth among competing applications and may "automatically select for [bandwidth] upgrade the application that is most active in bandwidth usage." *See* Liao at paragraph 0054. Thus, Liao teaches away from displaying the required bandwidth (relative to the available bandwidth, for example) since the required bandwidth determination is disclosed in Liao as an **intermediate step** that leads to the **"automatic" allocation of bandwidth** among **competing applications**.

The Office Action further alleges that motivation to modify Liao may be inferred as follows: "This is beneficial in that **manual adjustment of bandwidth usage** can be determined by the visual display." However, Liao specifically **teaches away** from **manual adjustment of bandwidth usage**. Liao discloses that "the cellular phone may **automatically** select for upgrade the application that is most active in bandwidth usage." In other embodiments, Liao discloses that "a suitable screen may pop up listing the currently running applications and prompting the user **to select one of the applications** for a bandwidth upgrade." *See* Liao, at paragraph 0054. In both of these disclosed embodiments, however, Liao **includes no objective teaching** for **displaying** the **required bandwidth** for transmitting and receiving signals, and instead repeatedly discloses various concepts for selecting an **"application"** (either "automatically" or via a user selection of such an application) for an allocation of additional bandwidth and updating a display **to indicate the additional bandwidth made available by such an allocation**. *See* Liao, at paragraph 0055. Thus, Liao teaches away from the "beneficial" aspects of the proposed modification to Liao that results in the pending rejections of independent Claims 1, 21, and 41 and further contains no objective teaching or suggestion to display the "required bandwidth" for transmitting and receiving signals via a current communications system.

Applicants respectfully submit that the rejections of Claims 1, 21, and 41 are the result of the improper use of hindsight to modify Liao in light of the disclosure of the present application.

The Federal Circuit has repeatedly warned against using the applicant's disclosure as a blueprint for reconstructing the claimed invention out of isolated teachings in the prior art. See, *e.g. Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988). Furthermore, the Federal Circuit has also held that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *See* MPEP §2143.01 (II), citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicants further point out that "a prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention." *See* MPEP §2143.01 (VI), citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). As discussed herein, Liao does not teach or suggest the desirability of **displaying the required bandwidth for transmitting and receiving** signals on the current communications system, and more particularly focuses on the desirability of tracking the bandwidth usage of currently active applications so as to **select one of the applications** for an **automatic** bandwidth upgrade (thereby **negating the desirability of displaying the required bandwidth** relative to an available bandwidth to aid a user in a manual adjustment of bandwidth usage).

Thus, for at least the reasons stated above, Applicants respectfully submit that the pending rejections of Claims 1, 21, and 41 (and Claims 6-9, 26-29, and 46-49 depending respectively therefrom) under 35 U.S.C. §103(a) are improper, and that Claims 1, 21, and 41 (and Claims 6-9, 26-29, and 46-49 depending respectively therefrom) are patentable over Liao.

Claims 3, 11, 23, 31, 43 and 51

Claims 3, 11, 23, 31, 43 and 51 have been rejected under 35 U.S.C. §103(a) as being obvious over Liao in view of U.S. Patent Application No. 2004/0048624 to Ko ("Ko"). The Applicants respectfully submit that Claims 3, 11, 23, 31, 43 and 51, all of which depend from at least one of Claims 1, 21, and 41, are patentable for at least the reasons stated above with respect to Claims 1, 21, and 41. In this regard, Ko also fails to teach or suggest the determination and display of the **required** bandwidth for transmitting and receiving signals on the current communications system **prior to modifying communications therewith** as recited by

independent Claims 1, 21 and 41 such that any combination of Liao and Ko likewise fails to teach or suggest amended independent Claims 1, 21 and 41, as well as Claims 3, 11, 23, 31, 43 and 51 that depend therefrom.

Claims 5, 25, and 45

Claims 5, 25, and 45 have been rejected under 35 U.S.C. §103(a) as being obvious over Liao in view of U.S. Patent No. 6,501,770 to Arsenault *et al.* ("Arsenault"). The Applicants respectfully submit that Claims 5, 25, and 45, which depend from Claims 1, 21, and 41, respectively, are patentable for at least the reasons stated above with respect to Claims 1, 21, and 41. In this regard, Arsenault also fails to teach or suggest the determination and display of the **required** bandwidth for transmitting and receiving signals on the current communications system **prior to modifying communications therewith** as recited by independent Claims 1, 21 and 41 such that any combination of Liao and Arsenault likewise fails to teach or suggest amended independent Claims 1, 21 and 41, as well as the claims that depend therefrom.

Claims 10, 30, and 50

Claims 10, 30, and 50 have been rejected under 35 U.S.C. §103(a) as being obvious over Liao in view of U.S. Patent Application No. 2004/0071081 to Rosenfled ("Rosenfled"). The Applicants respectfully submit that Claims 10, 30, and 50, which depend from Claims 1, 21, and 41, respectively, are patentable for at least the reasons stated above with respect to Claims 1, 21, and 41. In this regard, Rosenfled also fails to teach or suggest the determination and display of the **required** bandwidth for transmitting and receiving signals on the current communications system **prior to modifying communications therewith** as recited by independent Claims 1, 21 and 41 such that any combination of Liao and Rosenfled likewise fails to teach or suggest independent Claims 1, 21 and 41, as well as the claims that depend therefrom.

Claims 15, 35, and 55

Claims 15, 35, and 55 have been rejected under 35 U.S.C. §103(a) as being obvious over Liao in view of Ko and further in view of Rosenfled. The Applicants respectfully submit that

Claims 15, 35, and 55, which depend from Claims 1, 21, and 41, respectively, are patentable for at least the reasons stated above with respect to Claims 1, 21, and 41. In this regard, neither Ko nor Rosenfled teaches or suggests the determination and display of the **required** bandwidth for transmitting and receiving signals on the current communications system **prior to modifying communications therewith** as recited by independent Claims 1, 21 and 41 such that any combination of Liao, Ko and Rosenfled likewise fails to teach or suggest independent Claims 1, 21 and 41, as well as the claims that depend therefrom.

Claims 12, 32, and 52

Claims 12, 32, and 52 have been rejected under 35 U.S.C. §103(a) as being obvious over Liao in view of Ko and further in view of U.S. Patent No. 5,630,159 to Zancho ("Zancho"). The Applicants respectfully submit that Claims 12, 32, and 52, which depend from Claims 1, 21, and 41, respectively, are patentable for at least the reasons stated above with respect to Claims 1, 21, and 41. In this regard, Zancho also fails to teach or suggest the determination and display of the **required** bandwidth for transmitting and receiving signals on the current communications system **prior to modifying communications therewith** as recited by independent Claims 1, 21 and 41 such that any combination of Liao, Ko and Zancho likewise fails to teach or suggest independent Claims 1, 21 and 41, as well as the claims that depend therefrom.

Claims 16, 36, and 56

Claims 16, 36, and 56 have been rejected under 35 U.S.C. §103(a) as being obvious over Liao in view of Ko and further in view of Rosenfeld and further in view of Zancho. The Applicants respectfully submit that Claims 16, 36, and 56, which depend from Claims 1, 21, and 41, respectively, are patentable for at least the reasons stated above with respect to Claims 1, 21, and 41. In this regard, none of Ko, Rosenfeld and Zancho teaches or suggests the determination and display of the **required** bandwidth for transmitting and receiving signals on the current communications system **prior to modifying communications therewith** as recited by independent Claims 1, 21 and 41 such that any combination of Liao, Ko, Rosenfled and Zancho

likewise fails to teach or suggest independent Claims 1, 21 and 41, as well as the claims that depend therefrom.

Claims 17, 18, 37, and 38

Claims 17, 18, 37, and 38 have been rejected under 35 U.S.C. §103(a) as being obvious over Liao in view of U.S. Patent No. 6,233,469 to Watanabe ("Watanabe"). In response to the Applicants' previous traverse of these rejections, the Office Action states that "both [Liao and Watanabe] disclose displaying data to users on a portable communications device, therefore it would have been obvious to a person of ordinary skill in the art to modify Liao to include the teachings of Watanabe, as it would provide a user with a better view of the display during calls." Applicants respectfully disagree and assert that **neither Liao nor Watanabe, nor the general knowledge of a person skilled in the art, includes a specific teaching, motivation, or suggestion to combine the teachings of individual items of prior art**, as is required for an obviousness rejection under §103.

The Applicants note that the Federal Circuit has consistently stated that a finding of obviousness requires **a specific teaching, motivation, or suggestion to combine the teachings of individual items of prior art**. See, e.g., *In Re Sang Su Lee*, No. 00-1158 (Fed. Cir. January 18, 2002) (**factual question of motivation to combine** is material to patentability and **could not be resolved on subjective belief and unknown authority**); *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (**a showing of a suggestion, teaching, or motivation to combine is an essential evidentiary component** of an obviousness holding); *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992) (Examiner can satisfy burden of obviousness in light of combination only by showing some **objective teaching** leading to the combination); and *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (**evidence of teaching or suggestion essential to avoid hindsight**).

The only alleged "objective teaching" presented in the Office Action is that the proposed combination "would provide a user with a better view of the display during calls." This advantage is **only suggestive of the proposed combination** of the cited references **when viewed in light of the disclosure of the present application.** Such a "suggestion" requires the use of

improper hindsight. For example, the fact that the apparatus disclosed in Watanabe provides a user with a better view of the display during calls **does not**, on its own, **suggest the desirability of the combination of Watanabe's teachings with that of Liao**, as Liao teaches that "the cellular phone may **automatically** select for upgrade the application that is most active in bandwidth usage." *See* Liao, at paragraph 0054. Thus, Watanabe contains no suggestion of the desirability of tracking bandwidth at all (as it is concerned only with the visibility of the display while the terminal is in use), and Liao suggests that bandwidth tracking should result in the **automatic selection of an application** that is most active in bandwidth usage for a bandwidth reallocation (thereby negating the need to view the display, as such bandwidth tracking and reallocation may be transparent to a user). The only suggestion of the desirability of the combination of a visible display and the tracking and display of bandwidth comes from the **disclosure of the present application** which is concerned with displaying an indication of a bandwidth available on a current communications system. As stated herein, the Federal Circuit has repeatedly warned against using the applicant's disclosure as a blueprint for reconstructing the claimed invention out of isolated teachings in the prior art. See, *e.g. Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

Thus, for at least the reasons stated above, Applicants respectfully submit that neither Liao nor Watanabe, alone or in combination, teach or suggest the combination of their individual teachings and therefore, that the pending rejections of Claims 17 and 37 under 35 U.S.C. §103(a) are improper. Applicants, further respectfully submit that the rejections of Claims 18 and 38, depending from Claims 17 and 37, are also improper for at least the reasons stated above.

Claims 19 and 39

Examiner has rejected Claims 19 and 39 under 35 U.S.C. §103(a) as being obvious over Liao in view of Ko and further in view of Watanabe. The Applicants respectfully submit that Claims 19 and 39, which depend from Claims 17 and 37, respectively, are patentable for at least the reasons stated above with respect to Claims 17 and 37. More specifically, because the proposed combination of Liao and Watanabe is improper, any combination of Liao, Ko and

Watanabe to reject Claims 19 and 39 is likewise improper as neither Liao nor Watanabe teach or suggest the combination of their individual teachings.

Claims 20 and 40

Examiner has rejected Claims 20 and 40 under 35 U.S.C. §103(a) as being obvious over Liao in view of Arsenault and further in view of Watanabe. The Applicants respectfully submit that Claims 20 and 40, which depend from Claims 17 and 37, respectively, are patentable for at least the reasons stated above with respect to Claims 17 and 37. More specifically, because the proposed combination of Liao and Watanabe is improper, any combination of Liao, Arsenault and Watanabe to reject Claims 19 and 39 is likewise improper as neither Liao nor Watanabe teach or suggest the combination of their individual teachings.

CONCLUSION

In conclusion, Liao, Watanabe, Ko, Rosenfled, Arsenault, and Zancho, alone or in combination, **do not** teach, suggest, or provide motivation for the embodiments of the present invention, as claimed in Claims 1, 17, 21, 37, and 41, and the claims depending therefrom. Accordingly, in view of the above differences between the Applicants' invention and the cited reference, the Applicant submits that the present invention, as defined by the pending claims, is patentable over the references cited in the Office Action. As such, for the reasons set forth above, the pending claims are believed to be in condition for immediate allowance and notice to such effect is respectfully requested at the Examiner's earliest opportunity.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

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